

REMARKS

Claims 1-51 are pending and at issue in the application with claims 1, 4, 24, 41 and 47 being independent claims. As a result, 5 independent claims exist in the application as previously paid for, and 51 total claims exist in the application as previously paid for. The applicants believe no fee is due. However, the Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 13-2855. Reconsideration and withdrawal of the rejections in view of the remarks below is respectfully requested.

Double-Patenting Rejections

The applicants respectfully traverse the judicially created doctrine of obviousness-type double patenting rejection of claims 1-15 and 17-51 over co-pending U.S. Application Serial No. 10/178,876 ("the '876 application) in view of Slomiany et al. (U.S. Patent No. 6,612,927), and the rejection of claims 4 and 16 over the '876 application in view of Slomiany et al. and further in view of co-pending U.S. Application Serial No. 09/904,061 (the '061 application). In particular, it is clear that an obviousness-type double patenting rejection can only exist between an application and an issued patent. Neither the present application nor the '876 application has issued as a patent. As a result, a double patenting rejection cannot be maintained between the present application and the '876 application. See MPEP 804(I).

Further, the action does not make out a *prima facie* case of obviousness-type double patenting. In particular, the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. However, for the reasons provided below with respect to Slomiany et al., it is clear that the action does not make out a *prima facie* case of obviousness-type double patenting because the references fail to disclose all of the limitations of claims 1-51, and the action provides an insufficient motivation to combine or modify the references.

35 U.S.C. §103(a) Rejections

The applicants respectfully traverse the rejections of claims 1-51 as unpatentable over Loose et al. (U.S. Patent No. 6,517,433) in view of Slomiany et al. The applicants also traverse the rejection of claim 16 as unpatentable over Loose et al. in view of Slomiany et al. and further in view of the '061 application.

Each of claims 1-51 recites a gaming system, gaming method or memory having a computer program capable of being used with a gaming apparatus, where a second wager on a first game type is prevented if it is determined that a predetermined or nonzero payout is associated with an outcome of a first game type, in which case a second game display is generated relating to a second game type. A second wager on the first game type may be received once reset data is received.

The action does not establish a *prima facie* case of obviousness of claims 1-51 because the action has not demonstrated where either Loose et al. or Slomiany et al. discloses all of the limitations as recited by claims 1-51, because both Loose et al. and Slomiany et al. fail to disclose all of the limitations as recited by claims 1-51, and because the action provides an insufficient motivation to combine or modify Loose et al. and Slomiany et al.

The action does not establish a *prima facie* case of obviousness of claims 1-51 because the action has not demonstrated where either Loose et al. or Slomiany et al. discloses all of the limitations as recited by independent claims 1, 4, 24, 41 and 47. In particular, while the action appears to address some of the features of independent claims 1, 4, 24, 41 and 47, the action does not address the features of preventing a second wager on a first game type if at least a predetermined (or nonzero) value payout associated with the first game type is determined and receiving wager data representing a second wager on the first game type if reset data is received. The action does not cite to any portion of either Loose et al. or Slomiany et al. as disclosing these features, nor address these features in any manner. The Office bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of obviousness. The Office has not met that burden in the action, because the action has failed to properly account for the claim language of claims 1-51. See MPEP 706.02(j), 2142, 2143. Accordingly, the action has not presented a *prima facie* case of obviousness for claims 1-51, and the rejection of claims 1-51 as asserted in the action cannot be sustained.

In addition, the action does not establish a *prima facie* case of obviousness because the cited portions of both Loose et al. and Slomiany et al. fail to disclose all of the limitations of claims 1-51. In particular, neither the cited portions of Loose et al. nor Slomiany et al. disclose or suggest preventing a second wager on a first game type if at least a predetermined

(or nonzero) value payout associated with the first game type is determined, and receiving wager data representing a second wager on the first game type if reset data is received.

As acknowledged in the action, Loose et al. does not disclose displaying images relating to a second game when a first value payout for a first game is determined to be at least a predetermined amount. However, in addition to the action's admission, Loose et al. also does not disclose preventing a second wager on a first game type if at least a predetermined (or nonzero) value payout is determined, and then receiving a second wager on the first game type if reset data is received. Although Loose et al. discloses bonus games in addition to a basic slots game (see column 3, lines 11-27; column 4 lines 28-57), Loose et al. does not provide any additional disclosure that a second wager on the basic slots game is prevented upon determination of at least a predetermined (or nonzero) payout based on a first wager, with a second wager being received upon receiving reset data.

Likewise, the cited portions of Slomiany et al. do not disclose preventing a second wager on a first game type if at least a predetermined (or nonzero) value payout is determined, where a second wager is received on the first game type if reset data is received. Although Slomiany et al. discloses placing multiple bets on different stages of a game and advances from one stage game to the next upon the occurrence of an advancement condition (see e.g., Abstract; column 1, line 56 to column 3, line 67), Slomiany et al. does not appear to disclose preventing a second wager on the first stage if a predetermined (or nonzero) value payout is determined. For example, if the player did not wager on the second stage, the player may continue wagering on the first stage even upon the occurrence of an advancement condition (e.g., a winning condition). Even if the player wagered on the second stage, Slomiany et al. does not disclose preventing additional wagers on the first stage. Further, any subsequent wager on the first stage is received upon a terminating condition, not upon receiving reset data. (See e.g., Figs. 10A-10E). By contrast, each of claims 1-51 prevents a second wager on a first game type if a first value payout is at least a predetermined (or nonzero) amount, with a second wager being received upon receiving reset data.

Further, the cited portions of Slomiany et al. do not disclose causing a second game display to be generated if a first value payout is determined to be at least a predetermined (or nonzero) amount. In particular, the cited portions of Slomiany et al. do not disclose the advancement condition as being at least a predetermined amount or nonzero amount. Instead,

Slomiany et al. appears to merely disclose the advancement condition as either a "winning" condition or a "special card" (Free Ride) condition. (See e.g., column 1, line 56 to column 2, line 57). That is, Slomiany et al. is dependent up a win rather than an associated payout, or a free game rather than a payout. Although Slomiany et al. discloses that the advancement condition may involve different rules, it remains that Slomiany et al. does not appear to go on to disclose at least a predetermined payout or a nonzero payout as an advancement condition.

Accordingly, neither Loose et al. nor Slomiany et al. discloses or suggests preventing a second wager on a first game type if a predetermined (or nonzero) value payout associated with the first game type is determined, causing a second game display to be generated relating to a second game type if a predetermined (or nonzero) value payout associated with the first game type is determined or receiving the second wager if reset data is received. It is clear that a *prima facie* case of obviousness cannot be established where all the limitations of a claimed combination are not taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP 2143.03. Accordingly, the action has not presented a *prima facie* case of obviousness for claims 1-51, and the rejection of claims 1-51 as asserted in the action cannot be sustained.

Still further, the motivation provided in the action is insufficient because the asserted motivation (i.e., player wait time due to a system lockup event) is not found within the disclosures of Loose et al. or Slomiany et al. Indeed, the action does not provide any indication as to the source of the motivation, whether explicitly or implicitly in the references themselves. Instead, the action asserts, without any supporting evidence, that "the motivation ... comes from the well-known system lockup event that happens when the player hits a jackpot and the player has to wait several minutes of the attendant to come signal the system to allow the player to continue playing a new game of the same type of a totally different game." However, the asserted motivation is clearly derived from the disclosure of the application (see application, page 1, lines 4-32):

"... the entire gaming apparatus was disabled when a jackpot or other large payout determination occurred. ... The player had to wait for an attendant to re-enable or reset the gaming apparatus to allow the player to continue playing a game on the gaming apparatus. ... Sometimes it took a relatively long time (e.g., 5-30 minutes) just for the attendant to arrive. Only when the gaming apparatus was reset could the player resume playing on the gaming apparatus.").

However, the teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP 2143. The action does not provide any other evidence as to the source of the asserted motivation. If a system lock-up event is a motivation considered to be well-known in the art and derived from other than the applicants' disclosure, the applicants respectfully request production of authority supporting such a statement. See MPEP 2144.03. Otherwise, it is clear that the prior art must make a suggestion of or provide an incentive for a claimed combination of elements to establish a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). See also MPEP 2144.

Still further, the asserted motivation only identifies a problem within the prior art, but does not motivate one of ordinary skill in the art as to the solution to the problem. Even if the problem was well-known to one of ordinary skill in the art, the action has not established that one of ordinary skill in the art would have found the prevention of a second wager on a first game type and the generation of a display of a second game type if a first value payout of at least a predetermined (or nonzero) amount was determined, as an obvious solution to the problem of player wait time due to a system lockup event. Although a motivation to combine references may be found in the nature of the problem to be solved, one of ordinary skill in the art must still be motivated to combine the references to obtain the solution. For example, the motivation to combine the reference may be found in the nature of the problem to be solved if each reference is directed to the asserted problem. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004). See also MPEP 2143.01.

However, neither Loose et al. nor Slomiany et al. have been shown by the action to address the problem of player wait times due to a system lockup event, much less the solution for that problem as set forth in claims 1-51. Indeed, Loose et al. is directed to the problem of effecting more extravagant changes to the appearance of the display area (see column 1, lines 24-39), and Slomiany et al. is directed to the problem of allowing wagers on a plurality of game levels. (See column 1, line 7 to column 3, line 14). Accordingly, the action has not presented a motivation to combine the references, and therefore has not presented a *prima facie* case of obviousness for claims 1-51, and the rejection of claims 1-51 as asserted in the action cannot be sustained. See MPEP 2143 and 2144.

Indeed, the action's characterization of the problem of player wait times due to a system lockup event as "well known" admits the existence of a long felt need for a solution to the problem, which is an objective evidence of a secondary consideration of nonobviousness. See MPEP 2141(III).

Conclusion

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested. Should the examiner wish to discuss the foregoing, or any matter of form, in an effort to advance this application towards allowance, the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive
6300 Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300

By: _____

Aaron M. Peters
Registration No.: 48,801
Attorney for Applicants

February 13, 2007